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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,484	04/22/2004	William W. Shumway	HALB:052	7357
7590	02/18/2009		EXAMINER FIGUEROA, JOHN J	
Karen B. Tripp Attorney at Law P.O. Box 1301 Houston, TX 77251-1301			ART UNIT 1796	PAPER NUMBER
			MAIL DATE 02/18/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/829,484	SHUMWAY, WILLIAM W.
	<b>Examiner</b>	<b>Art Unit</b>
	JOHN J. FIGUEROA	1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 12 August 2008.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-14, 16-27 and 29-79 is/are pending in the application.  
 4a) Of the above claim(s) 38-56 and 62-79 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-14, 16-27, 29-37 and 57-61 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ .	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

### ***Revival from Abandonment***

1. A petition to revive this application under 37 C.F.R. 1.137(b) including the fee set forth in 37 CFR 1.17(e), was filed in this application after the abandonment of June 20, 2008, together with a response (hereinafter 'Response') to the prior non-final rejection of December 12, 2007 (hereinafter 'OA'). Applicant's petition for revival filed on August 12, 2008 has been granted and entered. Therefore, prosecution in this application has been reopened and examination in view of the amendment to the claims filed with Response is presented herein.

### ***Response to Amendment***

2. The 35 U.S.C. 103 rejection of claims 1-14, 16-27, 29-37, 57 and 59-61 as unpatentable over United States Patent Number (USPN) 5,990,050 to Patel et al. (hereinafter 'Patel') in view of "Amphiphilic Copolymers" to Perrin (hereinafter 'Perrin') that was previously made of record in item 2 on page 2 of OA has been withdrawn in view of Applicant's amendment to the claims in Response for reasons discussed below in the instant action.

3. The 35 U.S.C. 103 rejection of claim 58 as unpatentable over Patel in view of "Crude Oil Emulsions: A State of the Art Review" to Kokal (hereinafter 'Kokal') previously made of record in item 3 on page 2 of OA has been withdrawn in view of Applicant's amendment to the claim in Response as discussed below.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1, 26, 57 and 61, and claims 2-14, 16-25, 27, 29-37 and 58-60 that depend therefrom, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claims 1, 26, 57 and 61 have been amended to limit the non-surfactant polymeric emulsifier to be "ethylacrylate/methylacrylic acid". There is insufficient written description support in the specification for this new limitation in the claims. Although the specification had been amended during prosecution to provide generic descriptions for certain trademarks, such as ALCOSPERSE® 747; ALCOQUEST® 747; and ALCOGUM® SL-117, there has been no evidence proffered by Applicant showing that any of these polymers are indeed known as a non-surfactant "ethylacrylate/methylacrylic acid" polymeric emulsifier as recited in the presently amended claims.

***Allowable Subject Matter***

6. Claims 1-14, 16-27, 29-37 and 57-61, would be allowable if the rejection under 35 U.S.C. 112, 1st paragraph, set forth above in this Office action is overcome in a subsequent action.
7. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record does not teach or suggest a method of treating or drilling a subterranean formation that comprises providing a treatment/drilling fluid composition, said composition containing a surfactant-free emulsion that includes an oleaginous fluid; a second fluid partially immiscible with the oleaginous fluid; and a non-surfactant emulsifier absorbed at the interface between said oleaginous fluid and said second fluid, wherein the non-surfactant emulsifier is an ethylacrylate/methylacrylic acid copolymer having a molecular weight of about 100,000 that further contains hydrophilic and hydrophobic moieties.
8. The closest prior art reference is Patel. Patel discloses a drilling/working fluid composition for use in a subterranean formation that includes an invert emulsion fluid composition having an oleaginous fluid (oil phase) and an oil-soluble glycol ether (aqueous phase) that can be partially miscible in oil, and an emulsifier to stabilize the invert emulsion. However, although Patel lists a series of suitable emulsifiers (e.g. VERSACOAT®) that can be used in said composition to stabilize the invert-emulsion, Patel does not teach or suggest said emulsifier to be a non-surfactant

ethylacrylate/methylacrylic acid copolymer having a molecular weight of about 100,000 that further contains hydrophilic and hydrophobic moieties.

***Response to Arguments***

*The 35 U.S.C. 103 Rejection over Patel and Perrin (item 2 of OA)*

9. Applicant's arguments in Response with respect to the captioned 35 U.S.C. 103(a) rejection of claims 1-14, 16-27, 29-37, 57 and 59-61 as unpatentable over Patel in view of Perrin have been considered but deemed moot due to the new grounds of rejection in view of Applicant's amendment to independent claims 1, 26, 57 and 61, which limits the non-surfactant polymeric emulsifier to be an ethylacrylate/methylacrylic acid copolymer having a molecular weight of about 100,000 that further includes hydrophilic and hydrophobic moieties. As discussed previously in the instant action, Patel does not teach or suggest this non-surfactant polymeric emulsifier in accordance with the present claims, as amended. Nor does Perrin or Kokal supply this new limitation in the claims.

However, if Applicant removes this newly added limitation from the amended claims to overcome the aforementioned new matter rejection under 35 U.S.C. 112, first paragraph, this 35 U.S.C. 103 rejection of the claims over Patel and Perrin will be reinstated in its entirety.

*The 35 U.S.C. 103 Rejection over Patel, Perrin and Kokal (item 3 OA)*

10. Applicant's arguments in Response with respect to these 35 U.S.C. 103 rejection of claim 58 as unpatentable over Patel in view of Perrin, and further in view of Kokal, has been considered but deemed moot for the same reasons presented, *supra*, in the immediately preceding paragraph. As stated therein, if Applicant removes this newly added limitation from the claim, as amended, to overcome the new matter rejection of under 35 U.S.C. 112, first paragraph, this 35 U.S.C. 103 rejection of claim 58 over Patel, Perrin and Kokal will be reinstated.

### ***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Figueroa whose telephone number is (571)272-8916. The examiner can normally be reached on Monday-Thursday 8:00-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James J. Seidleck/  
Supervisory Patent Examiner, Art Unit 1796

JJF/JS